

## **REMARKS/ARGUMENTS**

### **Claims**

Claims 40-46, 48 and 49 are pending. Claims 40 and 48 are currently amended. The Applicant submits that the amended claims are supported at least by Figures 2 and 2a and do not add any new matter. Claims 41-46 and 49 are as previously presented.

### **Claim Rejections – 35 USC 112**

Claims 40-46, 48 and 49 were rejected as being indefinite. The Applicant requests that this rejection be reconsidered for the following reasons.

The Office Action noted the reference to "any portion of the lockset protruding through the front surface of the door" in (formerly) lines 25-26 of claim 40. This passage has been amended to refer to "any part of the portion of the lockset protruding through the front surface of the door." This clarifies that the Applicant is referring, in this part of the claim, to the portion of the lockset protruding through the front surface of the door introduced earlier in the claim.

The Office Action noted the reference to "a locking member" on lines 2-3 of claim 48. This phrase has been amended to "the locking member" to refer to the locking member introduced in claim 40.

The Applicant submits that the claims, as amended, are not indefinite.

### **Claim Rejections – 35 USC 103**

Claims 40-44 were rejected as being obvious over Olton (US 3271919) in view of British Patent Application No. 2 265 664. Claims 45, 46, 48 and 49 were rejected

as being obvious over Olton in view of British Patent Application No. 2 265 664 as applied to claims 40-44 further in view of other references. The Applicant requests that these rejections be reconsidered for the following reasons.

Claim 40 as amended defines a first U-shaped reinforcing member consisting of a base member and two substantially perpendicularly positioned side members. This repeats the same elements formerly provided in claim 40 except that the transitional phrase introducing these elements within the body of the claim as sub-elements of the first U-shaped reinforcing member has been changed from "comprising" to "consisting of". Further along in claim 40, the claim is amended to state that each of the side members is flat and generally rectangular. These amendments are supported by the previous version of claim 40 and by Figures 2 and 2b of the application.

The Office Action relies on element 14a of Figure 9 of Olton to provide the first U-shaped reinforcing member of claim 40. Door edge protector strip 14a of Olton has a web 17a, legs 15 and 16 and flanges 20 and 21. The Office Action equates the web 17a with the base member of claim 40 and the legs 15 and 16 with the side members of claim 40. Even if these characterizations were correct, however, the element 14a of Olton would not consist of a base member and side members since it also has flanges 20 and 21. The flanges 20 and 21 are not immaterial to the device in Olton, but rather are an important part of the Olton device. Flanges 20 and 21 are provided in all of the embodiments in Olton and the grooves 22 and 23 are cut in the door to received them (column 3, lines 44-48). Olton therefore does not provide a first U-shaped reinforcing member as claimed. British Patent Application No. 2 265 664 also does not provide a first U-shaped reinforcing member as claimed. Accordingly, the cited references, even if combined as suggested in the Office Action, would not provide all of the elements of claim 40 and so do not make the claim obvious.

The Applicant further submits that there is no prima facie case to combine the references as suggested in the Office Action. The Office Action argues that it would be obvious to one of ordinary skill in the art to combine the door edge protector strip 14a of Olton with a second plate 10 as shown in British Patent Application No. 2 265 664 to increase the security of the door system. The Applicant submits that there was no prima facie case that such a combination would have been obvious prior to the date of Applicant's invention. Olton is a "door edge protector" only in the sense that it "relates to door construction and particularly to decorative and protective edge protectors of durable material for preventing damage to the edges of architectural doors and, especially the vertical side edges of such doors." (column 1, lines 6-11) Olton further explains that, "... the hinges and striker edges of an open door are exposed to damaging bumps when, for example, furniture or other large objects are moved through doorways and by the doors in them." Olton's device is therefore not a security system at all. On the contrary, a person skilled in the art would appreciate that the grooves 22 and 23 in the door taught by Olton would probably decrease the security of the door. It is only with hindsight gained from the Applicant's invention that a person skilled in the art appreciates that a first U-shaped reinforcing member as claimed (which is not the same as the door edge protector strip 14a of Olson) can increase the security of a door. However, hindsight cannot be used in an obviousness analysis. Prior to Applicant's invention, there is no obvious reason to combine the second plate 10 from British Patent Application No. 2 265 664 with the door edge protector strip 14a of Olton.

The goal of increasing the security of a door system suggested in the Office Action would not have motivated the alleged combination prior to Applicant's invention. In order to make the combination suggested in the Office Action, a person skilled in the art reading both references and wanting to increase the security of a door would have to reject the first plate 2 of British Patent Application No. 2 265 664 and replace it with the door edge protector strip 14a of

Olton. This amounts to rejecting a device taught to increase the security of a door and replacing it with a device taught to protect the open edge of the door from being exposed to bumps from furniture moving through the doorway. If the goal is to increase the security of a door system, then it is not obvious to reject a component taught to provide security and replace it with a component taught only to prevent cosmetic damage to an open door.

The Applicant further submits that the Office Action does not establish a prima facie case that it would be an obvious matter of design choice as determined through routine experimentation and optimization to provide a second plate 10 as in British Patent Application No. 2 265 664 at least 12 inches long. When a claimed range is outside of the values used in the prior art (as in the present claim 40) then as stated in MPEP 2144.05 II B, a particular parameter must first be recognized as a result-effective before the determination of an optimum range might be considered as routine experimentation. The Office Action has not established with any evidence that length of a second reinforcing member was known to be a result effective parameter before Applicant's invention.


The Applicant submits in particular that the length of a second plate 10 in the alleged combination with the door edge protector strip 14a of Olton would not be considered a result effective variable. As discussed above, Olton does not teach a security device, and probably weakens the door by cutting grooves 22, 23 into the edge of the door. Accordingly, there is no reason or evidence of record to support an assumption that length of a second plate 10 to be used with a door edge protector 14a of Olton would be a topic of experimentation. British Patent Application No. 2 265 664 also provides no suggestion of a benefit to be had by experimenting with increasing the length of second plate 10. A longer second plate 10 would be heavier and more expensive. Guided by the cited references, a person skilled in the art would not obviously try to find the largest second plate

10 that they could use. They might instead try to find the smallest and least expensive.

For the reasons above, the Applicant submits that claim 40 is not obvious. Claims 41-46, 48 and 49 depend on claim 40 and are not obvious for at least the same reasons.

The Applicant requests and authorizes the Commissioner to treat this and any future response that requires a petition for an extension of time under 37 CFR 1.136(a) to be timely as incorporating a petition for extension of time for the appropriate length of time. The Applicant authorizes the Commissioner to charge all required extension of time fees to our deposit account number 022095.

Respectfully submitted,  
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